

**AMENDMENT UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 2129  
PATENT  
Application 10/626,443  
Attorney Docket 2002P12271US01 (1009-285)**

**REMARKS**

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1 and 43-45 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-45 are now pending in this application. Each of claims 1 and 43-45 is in independent form.

**I. The Enablement Rejections**

Each of claims 1, 43, 44, and 45 was rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement, and thus was asserted to be unpatentable because, “[t]hese [sic] is no explanation or description on which ‘pattern matching rules based on expert knowledge’ is to be employed within the invention.” These rejections are respectfully traversed.

Yet the Office Action fails to establish a *prima facie* case for a rejection based on non-enablement. A *prima facie* case of non-enablement requires that the Office Action provide:

1. a rational basis as to:
  - a. why the disclosure does not teach (*see, Fiers v. Sugano*, 984 F.2d 1164, 25 UPSQ2d 1601, 1607 (Fed. Cir. 1993) (*quoting Weil v. Fritz*, 601 F.2d 551, 555, 202 USPQ 447, 450 (CCPA 1979)), or .

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- b. why to doubt the objective truth of the statements in the disclosure that purport to teach (*see, Fiers v. Sugano*, 984 F.2d 1164, 25 USPQ2d 1601, 1607 (Fed. Cir. 1993) (*quoting In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 ( 1969)));
  2. a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure (*In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993));
    - a. without undue experimentation (*see, In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 219 (1976) (*citing In re Armbruster*, 512 F.2d 676, 185 USPQ 152 ( 1975));
    - b. and dealing with subject matter that would not already be known to the skilled person as of the filing date of the application (*see, Webster Loom v. Higgins*, 105 U.S. (15 Otto) 580 (1881)).

The need for presenting a *prima facie* non-enablement rejection is explained at MPEP 2164.04 ("it is incumbent on the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." *In re Marzocchi*, 439 F.2d 220,224, 169 USPQ 367, 370 (CCPA 1971) (emphasis in original)).

The present Office Action fails to provide any evidence whatsoever regarding any of the elements required for a *prima facie* non-enablement rejection. By contrast, included herewith is a Declaration under 37 C.F.R. § 1.132 of Mr. Michael Hogan, an inventor of record of the present application and one skilled in the art of computer applications as of 6 August 2002, the priority date claimed by the present application. Paragraphs 10-16 of Mr. Hogan's Declaration provide evidence that one skilled in the art would have found the disclosure of the present application enables one having ordinary skill in the art to practice the claimed subject matter of each of claims 1-45 without undue experimentation.

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For at least these reasons, reconsideration and withdrawal of each rejection of each of claims 1, 43, 44, and 45 is respectfully requested.

## **II. The Anticipation Rejections**

Each of claims 1, 20, and 43-44 was rejected as anticipated, and thus unpatentable, under 35 U.S.C. 102(e). In support of the rejection, various portions of U.S. Patent 20010018643 ("Brown") were applied. These rejections are respectfully traversed as moot in view of the present amendments to each of claims 1, 43, and 44.

Specifically, each of claims 1, 43, and 44, from one of which claim 20 depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Brown teach, "obtaining configuration information from a computer-based control system, the configuration information from a validated biopharmaceutical batch process control system".

For at least this reason, it is respectfully submitted that the rejection of claims 1, 43, and 44 is unsupported by Brown and should be withdrawn. Also, the rejection of claim 20, which ultimately depends from independent claim 1, is unsupported by Brown and also should be withdrawn.

## **III. The Obviousness Rejections**

Each of claims 2-19, 21-42, 45 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 20010018643 ("Brown"), U.S. Patent 6195665 ("Jarett"), U.S. Patent 6996589 ("Jayaram"), U.S. Patent 6289266 ("Payson"), U.S. Patent 20010047420 ("Talanis"), a paper, John Mylopoulos, Huaiqing Wang, and Bryan Kramer, "Knowbel: A Hybrid tool for building expert systems", IEEE, February 1993, ("Mylopoulos"), U.S. Patent 20010056429 ("Moore"), U.S. Patent 6996589 ("Koizumi"), U.S. Patent 20020077711 ("Nixon"), and/or U.S. Patent 20020055804 ("Betawar"). Each of these rejections is respectfully traversed.

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**A. Legal Standards**

**1. Overview of *Prima Facie* Criteria for an Obviousness Rejection**

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.”

Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. “Inventions usually rely upon building blocks long since uncovered, and claimed discoveries almost necessarily will be combinations of what, in some sense, is already known.” Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. “Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.”

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instruct to “guard against slipping into the use of hindsight”.

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*KSR* further warned that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”.

To heed these warnings, *KSR* explained the “import[ance]” of “identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

Explaining the need for “a reason that would have prompted a person of ordinary skill”, *KSR* further taught that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” Further exploring this mandate, the Federal Circuit has recently recognized that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

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See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

## 2. Claim Construction

Before the *prima facie* obviousness criteria can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006) has clarified that:

1. “[t]he Patent and Trademark Office (‘PTO’) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art’” (*Id.* at 1316);
2. the words of a claim “are generally given their ordinary and customary meaning” (*Id.* at 1312);

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3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent, including the specification**” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor’s lexicography governs**” (*Id.* at 1316);
7. even “when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents” (*Id.* at 1321);
8. an “invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office” (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the “prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent” (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

### **3. Unfounded Assertions of Knowledge**

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such

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unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

#### **4. Determination of the Level of Skill**

Consistent with Graham, “the level of ordinary skill in the art is a factual question that must be resolved and considered.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Id.* Thus, the “examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and ‘not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand’.” MPEP 2141.03, quoting *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984).

#### **5. Pertinent Prior Art References**

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is “reasonably pertinent to the particular problem with which the invention was involved.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

“References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor” (quoting *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

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"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*citing In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*quoting Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

#### **6. Selection of Portions of References**

"It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 783 F.2d 1038, 1041 (Fed. Cir. 1986) (*quoting In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965)).

#### **7. The Applied Reference(s) Must Be Enabling**

"In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." *Rockwell Int'l Corp. v. U.S.*, 147 F.2d 1358, 47 USPQ2d 1027 (Fed. Cir. 1998); *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1471, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997); *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

#### **8. Next Office Action**

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based

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on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

**B. Analysis**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

**1. Claims 2-19 and 21-42**

**a. The Rejections are Moot**

Each rejection of each of claims 2-19 and 21-42 is traversed as moot in view of the present amendments to claim 1, from which each of claims 2-19 and 21-42 ultimately depends.

As indicated, *supra*, claim 1 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Brown teach, “obtaining configuration information from a computer-based control system, the configuration information from a validated biopharmaceutical batch process control system”. No evidence is of record that the remaining applied portions of the remaining relied-upon references overcome at least these deficiencies of Brown.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as

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**attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.**

**b. Lack of Required Factual Evidence of Obviousness**

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

**2. Claim 2**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 2, in such a manner so as to arrive at the claimed subject matter of claim 2. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 13:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using a consistence format as taught by Jayaram to converting the information into a common format. For the purpose of avoiding additional computing cost associated with two or more formats."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would

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have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 2 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 2 is respectfully requested.

### **3. Claim 3**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 3, in such a manner so as to arrive at the claimed subject matter of claim 3. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Pages 13-14:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by altering information into a user familiar syntax as taught by Jayaram to converting the information into a user-definable syntax. For the purpose of having the invention easier to use for the user due to the fact the user defines syntax is employed."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would

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have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 3 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 3 is respectfully requested.

#### 4. Claim 4

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 4, in such a manner so as to arrive at the claimed subject matter of claim 4. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 14:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using XML as taught by Jayaram to converting the information into XML. For the purpose of using an industrial standard code for ease of implementation across multiple platforms."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would

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have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 4 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 4 is respectfully requested.

#### **5. Claim 5**

Claim 5 states, *inter alia*, yet no substantial evidence is of record that the applied portions of Payson teach, "importing the first transformed version into the destination system, the first transformed version obtained from a Bailey INFI-90 configuration database." The present Office Action alleges, at Pages 21-22, that Payson teaches this claimed subject matter at "C5: 1-5". Yet this applied portion of Payson merely states:

[a] suitable control and data acquisition system is that marketed by Westinghouse under the designation WDPF Distributed Control System. Other suitable control and data acquisition systems are the Infi 90 available from Bailey Controls and products of Honeywell and Foxboro.

The mere statement that "the Infi 90 available from Bailey Controls" is a "suitable control and data acquisition system[]" provides no evidence that this applied portion of Payson teaches:

- "importing" anything whatsoever;
- a "first transformed version" of anything whatsoever;

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- any "destination system" whatsoever; or
- any "configuration database" whatsoever;

Thus, no evidence is of record that the applied portions of Payson teach, "importing the first transformed version into the destination system, the first transformed version obtained from a Bailey INFI-90 configuration database."

No evidence is of record that the applied portions of Brown overcome these deficiencies of Payson.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Payson, that are used in rejecting claim 5, in such a manner so as to arrive at the claimed subject matter of claim 5. Regarding the proffered combination of the applied portions of Brown and Payson, the present Office Action states, at Page 22:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using hardware as taught by Payson to importing the first transformed version into the destination system, the first transformed version obtained from a Bailey INFI-90 configuration database. For the purpose of using established hardware with proved results and compatibility history."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 5 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 5 is respectfully requested.

#### 6. Claim 6

Claim 6 states, *inter alia*, yet no substantial evidence is of record that the applied portions of Talanis teach, "importing the second transformed version into the destination system, the second transformed version comprising configuration elements associated with a WinCC operator console." The present Office Action alleges, at Pages 21-22, that Payson teaches this claimed subject matter at "¶ 0013". Yet this applied portion of Talanis fails to even mention "WinCC". For the purposes of this Reply, Applicant assumes that the present Office Action intended to apply paragraph 0017 of Talanis, which states:

[t]here is thus a user data communication 27 over the Internet in both directions independently in terms of timing, which user data communication 27 can be initiated by both sides. In this way, it becomes possible to use an existing communication path of the Internet for automation technology in a customary way for operator control and monitoring purposes as a HMI (Human Machine Interface). One possible advantageous application of this method is, for example, the operator control and monitoring system WinCC from Siemens.

The mere statement that an "advantageous application of this method is, for example, the operator control and monitoring system WinCC from Siemens" provides no evidence that this applied portion of Talanis teaches:

- "importing" anything whatsoever;
- a "second transformed version" of anything whatsoever;
- any "destination system" whatsoever; or

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- any "configuration elements" whatsoever;

Thus, no evidence is of record that the applied portions of Talanis teach, "importing the second transformed version into the destination system, the second transformed version comprising configuration elements associated with a WinCC operator console."

No evidence is of record that the applied portions of Brown overcome these deficiencies of Talanis.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Talanis, that are used in rejecting claim 6, in such a manner so as to arrive at the claimed subject matter of claim 6. Regarding the proffered combination of the applied portions of Brown and Talanis, the present Office Action states, at Page 22:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using hardware as taught by Payson to importing the first transformed version into the destination system, the first transformed version obtained from a Bailey INFI-90 configuration database. For the purpose of using established hardware with proved results and compatibility history."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus,

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the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 6 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 6 is respectfully requested.

**7. Claim 7**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Mylopoulos, that are used in rejecting claim 7, in such a manner so as to arrive at the claimed subject matter of claim 7. Regarding the proffered combination of the applied portions of Brown and Mylopoulos, the present Office Action states, at Page 24:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using APACS as taught by Mylopoulos to have parsing the information, the information obtained from an APACS control system configuration database. For the purpose of using established hardware with known reliability and performance for obtaining accurate results."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 7 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 7 is respectfully requested.

#### **8. Claim 8**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 8, in such a manner so as to arrive at the claimed subject matter of claim 8. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Pages 14-15:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using XML taught by Jayaram to expressing the information in an XML syntax. For the purpose of using an industrial standard code for ease of expression across multiple platforms."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 8 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 8 is respectfully requested.

**9. Claim 9**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Moore, that are used in rejecting claim 9, in such a manner so as to arrive at the claimed subject matter of claim 9. Regarding the proffered combination of the applied portions of Brown and Moore, the present Office Action states, at Page 25:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by introducing XSLT as taught by Moore to apply XSLT transforms to the information. For the purpose of using standard information technologies such as XSLT for obtaining reliable results."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 9 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 9 is respectfully requested.

**10. Claim 10**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Moore, that are used in rejecting claim 10, in such a manner so as to arrive at the claimed subject matter of claim 10. Regarding the proffered combination of the applied portions of Brown and Moore, the present Office Action states, at Page 26:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by applying XSLT to DHTML as taught by Moore to apply XSLT transforms to the information and generating DHTML. For the purpose of generating a interface which a user can interact with."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 10 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 10 is respectfully requested.

**11. Claim 11**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Moore, that are used in rejecting claim 11, in such a manner so as to arrive at the claimed subject matter of claim 11. Regarding the proffered combination of the applied portions of Brown and Moore, the present Office Action states, at Pages 26-27:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using DHTML abilities as taught by Moore to generate DHTML encoding a plurality of options for translating an element of the information. For the purpose of having a dynamic interface so the user can input translation requests."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 11 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 11 is respectfully requested.

**12. Claim 12**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 12, in such a manner so as to arrive at the claimed subject matter of claim 12. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 15:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having options as taught by Jayaram to generating a plurality of options adapted for use in translation of an element of the information. For the purpose of being able to generate options for obtaining different translations as needed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 12 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 12 is respectfully requested.

**13. Claim 13**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Moore, that are used in rejecting claim 13, in such a manner so as to arrive at the claimed subject matter of claim 13. Regarding the proffered combination of the applied portions of Brown and Moore, the present Office Action states, at Page 27:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using DHTML as taught by Moore to interpreting a plurality of options adapted for use in translation of an element of the information using DHTML logic. For the purpose of using logic to provide accurate results obtained from the use of established software as DHTML logic."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would**

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recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based** on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 13 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 13 is respectfully requested.

**14. Claim 14**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 14, in such a manner so as to arrive at the claimed subject matter of claim 14. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 16:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by being able to view the options as taught by Jayaram to creating graphical user interface elements adapted to present a plurality of options for translating an element of the information. For the purpose of being able to view the possible options to use for translation functions."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the

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present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 14 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 14 is respectfully requested.

**15. Claim 15**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 15, in such a manner so as to arrive at the claimed subject matter of claim 15. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Pages 16-17:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by displaying the options as taught by Jayaram to presenting a plurality of options adapted for use in translation of an element of the information. For the purpose of being able to employ the possible options to use for translation functions."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the

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present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 15 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 15 is respectfully requested.

**16. Claim 16**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown, Jayaram, and Koizumi that are used in rejecting claim 16, in such a manner so as to arrive at the claimed subject matter of claim 16. Regarding the proffered combination of the applied portions of Brown, Jayaram, and Koizumi, the present Office Action states, at Page 29:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by presenting multiple options to multiple users as taught by Koizumi and Jayaram to presenting to each of a plurality of users, a plurality of options adapted for use in translation of an element of the information. For the purpose of dividing the work tasks into different sections for increased productivity per time."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the

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present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 16 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 16 is respectfully requested.

**17. Claim 17**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown, Jayaram, and Koizumi that are used in rejecting claim 17, in such a manner so as to arrive at the claimed subject matter of claim 17. Regarding the proffered combination of the applied portions of Brown, Jayaram, and Koizumi, the present Office Action states, at Page 30:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by presenting multiple options of translations to multiple users as taught by Koizumi and Jayaram to presenting to each of a plurality of users, a plurality of options adapted for use in translation of an element of the information, the plurality of options and the information element differing for each of the plurality of users. For the purpose of obtaining different translations for different users, such that user specialization can be utilized."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would

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have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 17 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 17 is respectfully requested.

**18. Claim 18**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 18, in such a manner so as to arrive at the claimed subject matter of claim 18. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 17:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by combining the GUI and the generated options as taught by Jayaram to presenting in the graphical user interface a plurality of options adapted for use in translation of an element of the information. For the purpose of reducing the effort to employ the options by using a GUI."

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The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 18 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 18 is respectfully requested.

**19. Claim 19**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 19, in such a manner so as to arrive at the claimed subject matter of claim 19. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 18:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by being able to accept input as taught by Jayaram to receiving a user-selected option from a plurality of options adapted for use in translation of an element of the information.

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For the purpose of having the invention take in input from the user so that the user can chose which translation options are desired."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 19 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 19 is respectfully requested.

#### **20. Claim 21**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 21, in such a manner so as to arrive at the claimed subject matter of claim 21. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 31:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by inputting multiple users translation request as taught by Nixon to receiving input from each

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of a plurality of users regarding each user's preference adapted for use in translation of an element of the information. For the purpose of a multiple of users being able to input data so that each user can receive outputs from their specific requests."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 21 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 21 is respectfully requested.

**21. Claim 22**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown, Betawar, and Koizumi that are used in rejecting claim 22, in such a manner so as to arrive at the claimed subject matter of claim 22. Regarding the proffered combination of the applied portions of Brown, Betawar, and Koizumi, the present Office Action states, at Pages 39-39:

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[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having multiple users in which one user can override another input as taught by Koizumi and Betawar to receiving input from each of a plurality of users regarding each user's preference for translating an element of the information, a first user's preference overriding a second user's preference. For the purpose of having more than one person being able to override a preference for increased accuracy or prevention of an error."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 22 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 22 is respectfully requested.

## **22. Claim 23**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting

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claim 23, in such a manner so as to arrive at the claimed subject matter of claim 23. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 18:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by keeping a log as taught by Jayaram to tracking received user input adapted for use in translation of an element of the information. For the purpose of aiding the user by avoiding duplicate translation request.”

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 23 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 23 is respectfully requested.

**23. Claim 24**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting

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claim 24, in such a manner so as to arrive at the claimed subject matter of claim 24. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 19:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having audit trail generated as taught by Jayaram to providing an audit trail of the user input relating to a translation of an element of the information. For the purpose of keeping track of the cost for the translations of the invention for possible display to the user."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 24 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 24 is respectfully requested.

#### **24. Claim 25**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in

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the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 25, in such a manner so as to arrive at the claimed subject matter of claim 25. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Pages 19-20:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by outputting the audit trail as taught by Jayaram to providing an audit trail of the user input. For the purpose of displaying the cost of the translation to the user so that the user can use this information to avoid audit trail costs thresholds."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 25 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 25 is respectfully requested.

#### **25. Claim 26**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in

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the art would combine the applied portions of Brown and Jayaram, that are used in rejecting claim 26, in such a manner so as to arrive at the claimed subject matter of claim 26. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Page 20:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by allowing to repeat steps as taught by Jayaram to repeating said applying activity. For the purpose of repeating a step if required so that a desired result can occur."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 26 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 26 is respectfully requested.

#### **26. Claim 27**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jayaram, that are used in rejecting

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claim 27, in such a manner so as to arrive at the claimed subject matter of claim 27. Regarding the proffered combination of the applied portions of Brown and Jayaram, the present Office Action states, at Pages 20-21:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by being able to repeat a transformation as taught by Jayaram to repeating said transforming activity. For the purpose of employing an iteration technique for a desired result."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 27 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 27 is respectfully requested.

#### **27. Claim 28**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 28, in such a manner so as to arrive at the claimed subject matter of claim 28. Regarding the

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proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 32:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by providing output as taught by Nixon to have a view of the destination system. For the purpose of seeing the interface of the system and the results of the translation which are imposed on the destination system."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 28 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 28 is respectfully requested.

**28. Claim 29**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 29, in such a manner so as to arrive at the claimed subject matter of claim 29. Regarding the

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proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Pages 32-33:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by providing multiple views as taught by Nixon to have a plurality of differing views of the destination system, each of the plurality of differing views corresponding to a different use for the destination system. For the purpose of each user having their own view, due to the logic it would hinder the user to see results of other views which are of no concern to the user."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 29 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 29 is respectfully requested.

#### **29. Claim 30**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in

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the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 30, in such a manner so as to arrive at the claimed subject matter of claim 30. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 33:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using GUI interface as taught by Nixon to have in the graphical user interface the information and the second transformed version. For the purpose of using a GUI which allows for increase of ease of use for the user."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 30 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 30 is respectfully requested.

### **30. Claim 31**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in

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the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 31, in such a manner so as to arrive at the claimed subject matter of claim 31. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 34:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having multiple users input e allowed as taught by Nixon to have receiving input from each of a plurality of users regarding each user's preference adapted for use in translation of an element of the information. For the purpose of allowing the user to dictate translation needs thus permitting the user to focus in on specific translation elements."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 31 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 31 is respectfully requested.

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**31. Claim 32**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 32, in such a manner so as to arrive at the claimed subject matter of claim 32. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 34:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by altering an existing interface as taught by Nixon to have the second transformed version is based on the first transformed version. For the purpose of updating an interface for greater or lesser content for increased accuracy of field of use.”

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 32 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 32 is respectfully requested.

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**32. Claim 33**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 33, in such a manner so as to arrive at the claimed subject matter of claim 33. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 35:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by generating a new interface as taught by Nixon to have the second transformed version is not based on the first transformed version. For the purpose of looking at a completely different interface if needed to observe different scenarios for other solutions which are outside a specific domain."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 33 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 33 is respectfully requested.

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**33. Claim 34**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Koizumi, that are used in rejecting claim 34, in such a manner so as to arrive at the claimed subject matter of claim 34. Regarding the proffered combination of the applied portions of Brown and Koizumi, the present Office Action states, at Page 40:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using rules based on knowledge elements as taught by Koizumi to a pattern matching rule from the first plurality of pattern matching rules is based on a plurality of knowledge elements and at least one known relationship between the plurality of knowledge elements, each of the plurality of knowledge elements identifiable as an entity in the information. For the purpose of using rules that follow elements and there relationship between them which aids in viewing patterns as clusters (or relationships) and thus using rules only associated with a specific cluster (or relationship) and the associated efficiency."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus,

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the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 34 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 34 is respectfully requested.

**34. Claim 35**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Moore, that are used in rejecting claim 35, in such a manner so as to arrive at the claimed subject matter of claim 35. Regarding the proffered combination of the applied portions of Brown and Moore, the present Office Action states, at Page 28:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using XSLT as taught by Moore to have wherein XSLT is employed to translate the information. For the purpose of using standard information technologies such as XSLT for obtaining reliable results in translation tasks."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus,

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the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 35 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 35 is respectfully requested.

**35. Claim 36**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 36, in such a manner so as to arrive at the claimed subject matter of claim 36. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 35:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having information in a set as taught by Nixon to have at least one of the first plurality of patterns is a set. For the purpose of using set theory in a abstract way to reduce input parameters or established scenarios for greater efficiency.”

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus,

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the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 36 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 36 is respectfully requested.

**36. Claim 37**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 37, in such a manner so as to arrive at the claimed subject matter of claim 37. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 36:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having a hierarchy structure in patterns as taught by Nixon to have wherein at least one of the first plurality of patterns is a hierarchy. For the purpose of looking at hierarchy patterns related in a processing structure for increased understanding of an overall pattern."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 37 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 37 is respectfully requested.

**37. Claim 38**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 38, in such a manner so as to arrive at the claimed subject matter of claim 38. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 36:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by using naming conventions as taught by Nixon to have at least one of the first plurality of patterns is a naming convention. For the purpose of ease of search based on the name of patterns."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 38 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 38 is respectfully requested.

**38. Claim 39**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Nixon, that are used in rejecting claim 39, in such a manner so as to arrive at the claimed subject matter of claim 39. Regarding the proffered combination of the applied portions of Brown and Nixon, the present Office Action states, at Page 37:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having multiple users work on each other's input as taught by Nixon to have wherein the user input is derived from input from a first user and input from a second user. For the purpose of being to modify each other work for improved results."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would recognize** that alleged reason for making the particular claimed combination and does not

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evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 39 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 39 is respectfully requested.

**39. Claim 40**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Betawar, that are used in rejecting claim 40, in such a manner so as to arrive at the claimed subject matter of claim 40. Regarding the proffered combination of the applied portions of Brown and Betawar, the present Office Action states, at Page 42:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by users having different authority positions as taught by Betawar to wherein the user input is derived from input from a first user and input from a second user, the first user occupying a different position in a value chain than the second user. For the purpose of having the role of supervisor incorporated within the specification for increased accuracy."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the

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present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 40 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 40 is respectfully requested.

**40. Claim 41**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Betawar, that are used in rejecting claim 41, in such a manner so as to arrive at the claimed subject matter of claim 41. Regarding the proffered combination of the applied portions of Brown and Betawar, the present Office Action states, at Pages 42-43:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having users at different authority levels as taught by Betawar to have wherein the user input is derived from input from a first user and input from a second user, the first user occupying a different position in a business process than the second user. For the purpose of having the role of supervisor incorporated in a business setting within the specification for increased profits."

The present Office Action provides no evidence that the claimed subject matter would **have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the

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relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 41 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 41 is respectfully requested.

**41. Claim 42**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Betawar, that are used in rejecting claim 42, in such a manner so as to arrive at the claimed subject matter of claim 42. Regarding the proffered combination of the applied portions of Brown and Betawar, the present Office Action states, at Pages 42-43:

[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by having the supervisor being able to alter input of another user as taught by Betawar to have wherein the user input is derived from input from a first user and input from a second user, at least a portion of the input from the second user altering at least a portion of the input from the first user. For the purpose of the supervisor or making changes on lower level users input for modification or alteration for increased accuracy."

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The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 42 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 42 is respectfully requested.

**42. Claim 45**

**a. Missing Limitations**

As an initial matter, the rejection of claim 45 is traversed as moot in view of the present amendments to claim 45. Claim 45 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Brown teach, "obtaining information from an actual working fast food restaurant computer system". Instead, Brown allegedly asserts, at paragraph 0010:

[t]he scale calculations are usually executed by hand to determine the size and capacity of the equipment that will be required in each of the unit operations. Since the scale calculations are developed from the original conceptual design parameters, they are also subject to the same errors inherent in the initial conceptual design base.

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No substantial evidence has been presented that the applied portions of Jarett cure these deficiencies of the applied portions of Brown.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

**b. Lack of Required Factual Evidence of Obviousness**

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

**c. Lack of Evidence of a Reason to Combine References**

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Brown and Jarett, that are used in rejecting claim 45, in such a manner so as to arrive at the claimed subject matter of claim 45. Regarding the proffered combination of the applied portions of Brown and Jarett, the present Office Action states, at Page 12:

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[i]t would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of Brown by employing the invention in the fast food industry as taught by Jarett to have express the first transformed version and the second transformed version in a fast food restaurant information management destination system, the fast food restaurant information management system configured by the second transformed version to control information transfers in the fast food restaurant.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 45 cannot be sustained based upon the mere conclusory statements of the present Office Action.

**d. Conclusion**

For at least these reasons, reconsideration and withdrawal of the rejection of claim 45 is respectfully requested.

**IV. The Finality of the Office Action is Improper, Premature, and should be Withdrawn**

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information

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disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). *See MPEP 706.07(a)* (emphasis added).

The present Office Action introduces rejections of each of claims 1, 43, 44, and 45 under 35 U.S.C. 112 as allegedly "failing to comply with the enablement requirement". The rejection of each of claims 1, 43, 44, and 45 under 35 U.S.C. 112 was not necessitated by Applicant's amendment of claims. The language of the claims that allegedly failed to comply with the enablement requirement was present in the claims as originally submitted.

Applicant respectfully submits that the finality of the 27 December 2007 Office Action is premature. Thus, Applicant respectfully requests that the finality of the 27 December 2007 Office Action be withdrawn.

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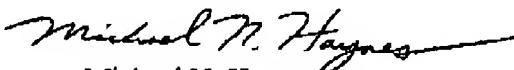
**CONCLUSION**

It is respectfully submitted that the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Date: 22 February 2008

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